REMARKS

The claims have not been amended. Accordingly, claims 1-2, 4-14, and 18-26 are currently pending in the application, of which claims 1, 8, 11 and 18 are independent claims.

In view of the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 103

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. I, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Telefex, Inc.*, 550 U.S. __, slip op. at 14-15 (2007). Thus, even if the prior art may be combined, the references when combined must disclose or suggest all of the claim limitations. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-2, 4, 8-14, and 18-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 applied for by Nguyen, *et al.* ("Nguyen") in view of U.S. Patent Application Publication No. 2003/0176205 applied for by Oota, *et al.* ("Oota"), and further in view of U.S. Patent No. 6,493,431 issued to Troen-Krasnow, *et al.* ("Troen-Krasnow"). Applicant respectfully traverses this rejection for at least the following reasons.

"All of the Claim Limitations"

The cited references do not render the present invention obvious because, even assuming *arguendo* that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claims 1, 8, 11, and 18.

Claim 1

Specifically, Applicant respectfully submits that the cited references fail to disclose or suggest all features of claim 1. Claim 1 recites, *inter alia*,

> a messenger service system …for sending a second notification message to a personal computer, <u>the second notification message for providing notification that the called mobile communication terminal is receiving the incoming message</u>. (emphasis added)

Nguyen, Oota, and Troen-Krasnow, either alone or in combination, fail to disclose at least these features.

The examiner relies upon Nguyen's SMS message containing the Data Waiting Indicator, as described in paragraphs [0007] and [0008], to disclose a "notification message" of claim 1. However, when Nguyen's SMS message is sent to the called mobile station, an incoming data call intended for the called mobile station has been received only at the application server in the data network overlay. See paragraph [0008]. At that time, the mobile station is "operating in a voice mode," and <u>is not receiving the incoming data call when the SMS message is received</u>. Paragraph [0008]. The <u>incoming data call</u> is routed to the called mobile station <u>only after</u> the called mobile station "accept[s] the incoming data call" <u>in response to the SMS message</u>. Therefore, Nguyen's SMS message does not disclose "notification that the called mobile communication terminal <u>is receiving</u> the incoming message" (emphasis added).

Further, Troen-Krasnow fails to remedy the shortcomings of Nguyen. As described in Troen-Krasnow, a message server "sends a notification to the called party that a call <u>has been received</u>." See Troen-Krasnow, col. 5, lines 1-2 (emphasis added). This notification message is sent from the message server <u>only after</u> the called telephone is "busy or the calling party receives no answer." See Troen-Krasnow, col. 4, line 18. The message is transmitted to the called party's computer <u>after</u> the telephone call is transferred away from the telephone system and "to the message server." Col. 4, lines 19-20. Thus, Troen-Krasnow's message also fails to disclose "notification that the called mobile communication terminal <u>is receiving</u> the incoming message" (emphasis added).

Moreover, apparently as justification for combining Nguyen with Troen-Krasnow, the examiner concludes that an advantage of sending an incoming call notification message to a personal computer according to Troen-Krasnow would enable a mobile user "to be notified of his/her incoming calls" while "his/her mobile phone is shut off or radio communication is suppressed." Office Action, page 4. Applicant finds no support for this conclusion in Troen-Krasnow's system, which sends a message to a personal computer <u>after an incoming call is missed</u>. Thus, at best, Troen-Krasnow notifies calls that were missed. Further, the examiner cites to no authority or basis for this justification. Such an unsupported conclusion, which summarily rejects Applicant's invention as obvious, cannot be maintained.

Finally, Oota fails to remedy the shortcomings of both Nguyen and Troen-Krasnow. As the examiner correctly notes, Oota generally discloses a mobile communication terminal with a first notifying section and a second notifying section. Oota, paragraph [0007]-[0008]. However, these portions of Oota fail to remedy the shortcomings of Nguyen and Troen-Krasnow. Specifically, as stated in paragraph [0008] (but excluded from the examiner's quotation of Oota in the Office Action), Oota's second notifying section is for "notifying an unanswered incoming call by causing a light emitting element to emit light <u>after the second detection section detects</u>

the cancellation of the incoming call." Thus, the notification provided by the second notifying

section comes only <u>after</u> the incoming call has been <u>canceled</u>. See also Oota, paragraph [0038]

(explaining that the "unanswered incoming call message" is created only if the "incoming call is

canceled before the incoming call response operating is carried out by the user."); Fig. 3

(disclosing that step 3g occurs only after step 3f - "Cancellation of incoming call?" - is answered

in the affirmative). This is consistent with Oota's purpose, which is to remedy the fact that a

"user cannot know the occurrence of an <u>unanswered incoming call</u> unless he or she intentionally

looks at the LCD." Oota, paragraph [0006] (emphasis added). For at least this reason, Oota's

notification provided by the second notifying section also fails to disclose "a second notification

message for providing notification that the called mobile communication terminal <u>is receiving</u> the

incoming message" (emphasis added).

For at least these reasons, the cited references do not render claim 1 obvious because,

even assuming *arguendo* that the cited references may be combined, the combined references

fail to disclose or suggest all features of independent claim 1.

Claim 8

Similarly, Applicant respectfully submits that the cited references fail to disclose or

suggest all features of claim 8. Claim 8 recites, *inter alia*,

> wherein the messenger service system sends a second
> notification message to a personal computer, the second
> notification message for providing notification <u>that the called
> mobile communication terminal is receiving the incoming
> message</u>. (emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, and

Troen-Krasnow, either alone or in combination, fail to disclose at least these features.

Specifically, the cited references fail to disclose "the second notification message for providing

notification that the called mobile communication terminal <u>is receiving the incoming message</u>" (emphasis added).

For at least these reasons, the cited references do not render claim 8 obvious because, even assuming *arguendo* that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 8.

Claim 11

Applicant respectfully submits that the cited references also fail to disclose or suggest all features of claim 11. Claim 11 recites, *inter alia*,

> a messenger server for sending a second notification message to a personal computer corresponding to the IP address,
>
> wherein the second notification message provides notification <u>that a called mobile communication terminal of the called subscriber is receiving an incoming message transmitted to a wireless communication system</u>. (emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, and Troen-Krasnow, either alone or in combination, fail to disclose at least these features. Specifically, the cited references fail to disclose "the second notification message provides notification that a called mobile communication terminal … <u>is receiving an incoming message</u> transmitted to a wireless communication system" (emphasis added).

For at least these reasons, the cited references do not render claim 11 obvious because, even assuming *arguendo* that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 11.

Claim 18

Applicant respectfully submits that the cited references fail to disclose or suggest all features of claim 18. Claim 18 recites, *inter alia*,

> providing notification to a personal computer
> corresponding to the IP address <u>that the called mobile
> communication terminal is receiving the incoming message</u>.
> (emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, and Troen-Krasnow, either alone or in combination, fail to disclose at least these features. Specifically, the cited references fail to disclose "providing notification to a personal computer corresponding to the IP address <u>that the called mobile communication terminal is receiving the incoming message</u>" (emphasis added).

For at least these reasons, the cited references do not render claim 18 obvious because, even assuming *arguendo* that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 18.

For at least these reasons asserted above, Nguyen, Oota, and Troen-Krasnow, either alone or in combination, fail to disclose every feature of claims 1, 8, 11 and 18.

"Scope of the Prior Art"

The cited references also fail to render the present invention obvious in view of the scope and contents of the prior art. Specifically, the examiner has failed to hurdle the gaps in the scope of the cited references.

In combining Nguyen, Troen-Krasnow, and Oota, the examiner has examined discrete elements of claims 1, 8, 11, and 18 in isolation without considering the invention as a whole. For example, the Office Action offers no explanation how Oota's incoming-call notifying function could be used to modify Nguyen's system, which sends a message to a user <u>before an</u>

incoming call is received, and Troen-Krasnow's system, which send a message <u>after an</u>
<u>incoming call is missed</u>. In rejecting the present claims, the examiner has failed to consider how
these three distinct purposes could be combined into a single system that would claims 1, 8, 11,
and 18 obvious when considered as a whole.

Claims 5-7

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable
over Nguyen in view of Oota, further in view of Troen-Krasnow, and still in further view of U.S.
Patent Application Publication No. 2005/0097142 applied for by Best, *et al.* ("Best"). Applicant
respectfully traverses this rejection for at least the following reasons.

Not withstanding the allowability of claims 5-7 for their dependence from allowable claim
1 as asserted above, Applicant respectfully traverses this rejection at least because Applicant
disqualified Best as a reference under § 102(e) in the Reply and supporting documents filed on
March 6, 2007.

Best is a U.S. Patent Application Publication and is available under 35 U.S.C. § 102(e)
as of its effective U.S. filing date, October 30, 2003. See MPEP § 2136.01(I) & MPEP §
706.02(V)(C). The present Application properly claims priority to and the benefit of Korean
Application No. 2003-0065175, filed on September 19, 2003, and thus establishes a date of
invention that is earlier than Best's effective U.S. filing date.

In accordance with 37 CFR § 1.55(a)(1), Applicant timely filed a claim of priority to
Korean Application No. 2003-0065175 on February 27, 2004. To disqualify Best as a valid
reference under 35 U.S.C. § 102(e), Applicant submitted a certified copy of Korean Application
No. 2003-0065175, an English translation thereof, and a statement that the translation of the
certified foreign priority document is accurate in accordance with 37 CFR § 1.55(a)(4)(ii) on
March 6, 2007.

Further, the examiner apparently found these arguments persuasive in the Office Action mailed June 4, 2007, in which the examiner stated "Arguments with respect to claims 5-7 are persuasive. Thus the rejection of claims 5-7 [based on Best] under 35 USC § 103 is withdrawn."

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5-7. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of claims 5-7, Applicant respectfully submits that these claims are allowable.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 11 and 18. Claims 2, 4-7, 9-10, 12-14, and 19-26 each depend from one of these independent claims and are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant respectfully submits that independent claims 1, 8, 11 and 18, and all the claims that depend therefrom, are allowable.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

/hae-chan park/

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